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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,769	05/03/2001	Michael T. Loos	26625-705	6637
21971	7590	08/08/2005	EXAMINER	
WILSON SONSINI GOODRICH & ROSATI 650 PAGE MILL ROAD PALO ALTO, CA 94304-1050			CHANG, JUNGWON	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/848,769	LOOS ET AL.
	Examiner	Art Unit
	Jungwon Chang	2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 16 May 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-37 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-37 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/16/05.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

FINAL ACTION

1. This office action is responsive to amendment filed on 5/16/2005. Claims 1-37 are presented for examination.
2. The objections of claims 1, 12, 29, 34 and 37 are withdrawn based on the amendment filed on 5/16/2005.
3. The affidavit filed on 5/16/2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Carini reference.
4. The affidavit is ineffective because it was not properly executed. It was not signed by all inventors.
5. The following parties may make an affidavit or declaration under 37 CFR 1.131:
 - (A) All the inventors of the subject matter claimed.
 - (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.
 - (C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed

by the 37 CFR 1.47 applicant or the legal representative, where appropriate.

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903). Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. Further, where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient. However, the affidavit or declaration, even though signed by fewer than all the joint inventors, must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection. *In re Carlson*, 79 F.2d 900, 27 USPQ 400 (CCPA 1935). (MPEP 715.04).

6. Applicant has not met any of the criteria above. Therefore, the affidavit is ineffective on its face.

7. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Carini reference. Applicant attempts to establish prior invention by showing RTP of the invention prior to April 17, 2000, the effective filing date of Carini reference. Proof

of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. A written description does not constitute an actual reduction to practice. Furthermore, only the filing of a US patent application which complies with the disclosure requirement of 35 USC 112 constitutes a constructive reduction to practice. A written description, no matter how complete, does not qualify as an actual reduction to practice.

Accordingly, applicant has not established prior invention.

8. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Carini reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). MPEP 715.07.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131. MPEP 715.07.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

9. To support conception, Applicant states in the affidavit that "Attached hereto as Exhibit 1 is a selection of engineering notebook pages dating from January 1999 to June 1999".

10. There is not clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. It is not clear to the examiner how the exhibit supports conception of the claimed invention. For example, claim 27 requires "A system for extending enterprise data to a mobile device, the system comprising:

a mobile application server operable to interface to an enterprise system and a mobile computing device; and

a domain data store communicatively coupled to the mobile application server,
the domain data store operable to store data from the enterprise system;

wherein the mobile application server is operable to:

establish a communication link with a mobile computing device;

receive transactions from the mobile computing device, the transactions
comprising data operations performed on a mobile data store prior to the establishment
of a wireless communication link;

modify the domain data store to reflect the transactions; and

communicate a portion of the domain data store to the enterprise system."

It is not clear where all the limitation above is supported in the notebook pages.

11. The evidence submitted is insufficient to establish diligence from a date prior to
the date of reduction to practice of the Carini reference to either a constructive reduction
to practice or an actual reduction to practice. In determining the sufficiency of a 37 CFR
1.131 affidavit or declaration, diligence need not be considered unless conception of the
invention prior to the effective date is clearly established, since diligence comes into
question only after prior conception is established. Ex parte Kantor, 177 USPQ 455 (Bd.
App. 1958). Since applicant fails to establish conception, diligence need not be
considered.

12. Therefore, examiner maintains the rejection as stated in the previous office action
dated January 10, 2005.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1-5, 10-16, 19-23, 25-28, 30-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Carini et al. (US 6,636,873), hereinafter referred to as Carini.

15. As to claim 1, Carini discloses the invention as claimed, a method for extending enterprise data to a mobile device (col. 1, lines 9-11; col. 2, lines 31-40; col. 3, lines 10-14), the system comprising:

creating a domain data store (database; 420, fig. 4) comprised of data relating to an enterprise system (enterprise database; 404, fig. 4) (col. 5, lines 26-30; col. 6, lines 12-20 and 26-30);

establishing a communication link (416, fig. 4; col. 5, lines 30-34) with a mobile computing device (408, 410, 412, 414, fig. 4; col. 5, lines 11-16) (figs. 4-5; col. 5, lines 26-34), the mobile computing device including a mobile data store (604, 606, 607, fig. 6; col. 10, lines 20-32) comprised of at least a portion of the data (col. 2, lines 9-12; col. 2, line 58 – col. 3, line 5; col. 5, lines 26-30; col. 6, lines 42-66);

receiving transactions from the mobile computing device (col. 3, lines 21-30; col.

5, lines 45-49), the transactions comprising at least partially data operations performed on the mobile data store prior to the communication link being established (in a disconnected mode; col. 7, lines 21-29; col. 8, lines 53-57; col. 10, lines 4-6); modifying the domain data store to reflect the transactions (col. 5, lines 45-49; col. 6, lines 49-52); and

communicating a portion of the domain data store to the enterprise system (col. 5, lines 26-34; col. 6, lines 26-30 and 61-66; col. 7, lines 35-41; col. 9, lines 29-33).

16. As to claim 2, Carini discloses transmitting over a wireless communication link (wireless channel; col. 3, lines 56-58; col. 12, lines 3-6) an application to the mobile computing device (col. 9, lines 48-67), the application operable to create the mobile data store on the mobile computing device (col. 10, lines 20-32 and 50-59).

17. As to claim 3, Carini discloses receiving updates to the data from the enterprise system (col. 6, lines 58-61); modifying the domain data store to reflect the updates (col. 5, lines 26-30; col. 6, lines 26-35; col. 9, lines 29-33); and transmitting at least a portion of the domain data store to the mobile computing device (col. 6, lines 58-61).

18. As to claim 4, Carini discloses determining the portion of the domain data store to be transmitted to the mobile computing device based upon characteristics of the mobile computing device (limited memory, data processing capabilities; col. 1, line 53 – col. 2, line 8; col. 3, lines 21-30; col. 5, lines 38-45).

19. As to claim 5, Carini discloses determining the portion to be transmitted to the mobile computing device based upon an identity of a user of the mobile computing device (MD1-MD5, fig. 5; synchronization log is kept of all transactions for each of the mobile devices, MD1-MD5; col. 6, lines 42-66).

20. As to claim 10, Carini discloses authenticating a user of the mobile computing device prior to the modifying step (secure socket layer protocol; col. 8, lines 43-45).

21. As to claim 11, Carini discloses the communication link is a wireless communication link (wireless channel; col. 3, lines 56-58; col. 12, lines 3-6).

22. As to claim 12, it is rejected for the same reasons set forth in claim 1 above. In addition, Carini discloses establishing a wireless communication link (wireless channel; col. 3, lines 56-58; col. 12, lines 3-6) with a mobile computing device (408, 410, 412, 414, fig. 4; col. 5, lines 11-16) (figs. 4-5; col. 5, lines 26-34); synchronizing the mobile data store with the domain data store (col. 5, lines 38-49; col. 6, lines 42-61);

modifying the domain data store to reflect the synchronization (col. 5, lines 45-49; col. 6, lines 49-52).

23. As to claim 13, Carini discloses receiving transactions from the mobile computing

device (col. 3, lines 21-30; col. 5, lines 45-49), the transactions comprising at least partially data operations performed on the mobile data store prior to the communication link being established (in a disconnected mode; col. 7, lines 21-29; col. 8, lines 53-57; col. 10, lines 4-6).

24. As to claim 14, it is rejected for the same reasons set forth in claim 3 above.

25. As to claim 15, it is rejected for the same reasons set forth in claim 4 above.

26. As to claim 16, it is rejected for the same reasons set forth in claim 5 above.

27. As to claim 19, it is rejected for the same reasons set forth in claim 11 above.

28. As to claim 20, Carini discloses a method for accessing enterprise data from a mobile device (col. 1, lines 9-11; col. 2, lines 31-40; col. 3, lines 10-14), comprising: storing a mobile data store (604, 606, 607, fig. 6; col. 10, lines 20-32), the mobile data store comprised of at least a portion of data from an enterprise system (enterprise database; 404, fig. 4) (col. 2, lines 28-40; col. 2, line 58 – col. 3, line 5; col. 5, lines 26-30; col. 6, lines 42-66);

creating transactions comprising data operations performed on the mobile data store (col. 2, lines 9-12; data residing on the mobile device; col. 2, lines 28-30; mobile device data; col. 3, lines 22-23; col. 7, lines 21-29; col. 8, lines 53-57; col. 10, lines 4-6);

establishing a communication link (416, fig. 4; col. 5, lines 30-34) after creating the transactions with a mobile application server (402, fig. 4) (fig. 4; col. 5, lines 7-16 and 34-38), wherein the mobile application server (402, fig. 4) interfaces to a domain data store (420, fig. 4; col. 5, lines 24-25) separate from the enterprise system (404, fig. 4); and

transmitting the transactions to the domain data store (col. 3, lines 21-30; col. 4, lines 13-14; col. 5, lines 45-49; col. 7, lines 21-29).

29. As to claim 21, it is rejected for the same reasons set forth in claim 11 above.

30. As to claim 22, it is rejected for the same reasons set forth in claim 2 above.

31. As to claim 23, Carini discloses receiving updates to the data from the domain data store (col. 5, lines 45-49); and modifying the mobile data store to reflect the updates (col. 2, lines 31-40; col. 6, lines 56-57).

32. As to claim 25, it is rejected for the same reasons set forth in claim 10 above.

33. As to claim 26, Carini discloses signaling to the mobile application server that the mobile device is available for wireless communication (request for connection; col. 7, lines 7-20).

34. As to claim 27, it is rejected for the same reasons set forth in claims 1, 12 and 20 above. In addition, Carini discloses a mobile application server (402, fig. 4) operable to interface to an enterprise system (enterprise database; 404, fig. 4) and a mobile computing device (408, 410, 412, 414, fig. 4; col. 5, lines 11-16) (fig. 4); and a domain data store (420, fig. 4) communicatively coupled to the mobile application server (fig. 4; col. 5, lines 24-25), the domain data store operable to store data from the enterprise system (col. 6, lines 46-49; col. 9, lines 29-33); wherein the mobile application server is operable to:

establish a communication link with a mobile computing device (fig. 4; col. 5, lines 7-16 and 34-38);
receive transactions from the mobile computing device (col. 3, lines 21-30; col. 5, lines 45-49), the transactions comprising at least partially data operations performed on the mobile data store prior to establishment of a wireless communication link (in a disconnected mode; col. 7, lines 21-29; col. 8, lines 53-57).

35. As to claim 28, Carini discloses the mobile application server comprises executable code stored on a single computing platform (col. 8, lines 40-49).

36. As to claim 30, it is rejected for the same reasons set forth in claim 20 above. In addition, Carini discloses a computer readable medium (database, memory, storage; 404, 420, figs. 4-5; 604-607, fig. 6); application stored on the computer readable medium (col. 9, lines 43-67; col. 10, lines 20-32 and 50-59).

37. As to claim 31, it is rejected for the same reasons set forth in claim 11 above.

38. As to claim 32, it is rejected for the same reasons set forth in claim 30 above. In addition, Carini discloses a colonist (program) stored on the mobile computing device (col. 10, lines 20-32 and 50-59); receive an application (col. 9, lines 48-67), the application executable to form a mobile data store (storing information and instructions to be executed by processor; col. 10, lines 20-32 and 43-59).

39. As to claim 33, it is rejected for the same reasons set forth in claim 11 above.

40. As to claim 34, it is rejected for the same reasons set forth in claims 27 and 30 above. In addition, Carini discloses a mobile application server (402, fig. 4) stored on the computer readable medium (420, 422, fig. 4), the mobile application server operable to interface to an enterprise system (enterprise database; 404, fig. 4), a domain data store (420, fig. 4), and a mobile computing device (408, 410, 412, 414, fig. 4; col. 5, lines 11-16) (figs. 4-5).

41. As to claim 35, it is rejected for the same reasons set forth in claims 27 and 30 above. In addition, Carini discloses wherein the mobile application server (402, fig. 4) is operable to transmit the portion over a wireless communication link based upon characteristics of the mobile computing device (limited memory, data processing

capabilities; col. 1, line 53 – col. 2, line 8; col. 3, lines 21-30; col. 5, lines 38-45).

42. As to claim 36, Carini discloses wherein the portion is created prior to an establishment of a wireless communication link between the mobile application server and the mobile computing device (in a disconnected mode; col. 7, lines 21-29; col. 8, lines 53-57).

43. As to claim 37, Carini discloses the portion is created by pre-processing data from the enterprise system in anticipation of the establishment of the communication link (col. 6, lines 58-61; col. 7, lines 41-54).

Claim Rejections - 35 USC § 103

44. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

45. Claims 6-9, 17, 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carini et al. (US 6,636,873), in view of Herzog et al. (2003/0069874), hereinafter referred to as Herzog.

46. As to claims 6-9, 17, 18 and 24, Carini does not specifically disclose synchronizing step is performed periodically, at regular time intervals, or on interrupt basis. However, Herzog discloses the synchronizing step is performed periodically, at regular time intervals, or on interrupt basis (both these local and global synchronization operations may be initiated by the client application at regular, periodic intervals; page 4, [0051], [0055]; local database is required to be periodically synchronized with the information within the server database; page 6, [0075]; page 21, [0229]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Carini and Herzog because Herzog's predetermined time interval for synchronizing would improve backup and recovery performance in the event of failure by periodically updating both databases to reflect changes that have been made in one database in the other.

47. As to claim 7, Carini discloses modifying the domain data store to reflect changes in the data initiated by the enterprise system (col. 5, lines 26-30; col. 6, lines 26-35 and 61-66; col. 9, lines 29-33); and modifying the data on the enterprise system to reflect changes in the domain data store (col. 5, lines 26-30; col. 6, lines 26-35; col. 7, lines 35-41; col. 9, lines 29-33).

48. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carini et al. (US 6,636,873), in view of Devine et al. (2003/0041263), hereinafter referred to as

Devine.

49. As to claim 29, Carini does not specifically disclose primary server, an integration server communicatively coupled to the primary server and interfacing to the enterprise system; a connection server communicatively coupled to the primary server and interfacing to the mobile computing device; and a data management server communicatively coupled to the primary server, the integration server and the domain data store. Devine discloses primary server (24, fig. 4), an integration server (46, fig. 4) communicatively coupled to the primary server (24, fig. 4) and interfacing to the enterprise system (page 5, [0070], lines 5-9); a connection server (45, fig. 4) communicatively coupled to the primary server (24, fig. 4) and interfacing to the mobile computing device (107, fig. 4); and a data management server (42, fig. 4; page 5, [0069], lines 9-11) communicatively coupled to the primary server (24, fig. 4), the integration server (46, fig. 4) and the domain data store (32, fig. 4; page 10, [0122]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Carini and Devine because Devine's a plurality of servers would increase the capability of Carini's system by adding the multiple functionality of servers, thereby improving the customer service by more rapidly distributing desired resources to the user of the mobile device.

50. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

51. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jungwon Chang whose telephone number is 571-272-3960. The examiner can normally be reached on 9:30-6:00 (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWC

July 29, 2005


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